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In re Application of
KENNY et al.
Application No.: 09/194,875
PCT No.: PCT/EP97/02888
Int. Filing Date: 04 June 1997
Priority Date: 04 June 1996
Attorney Docket No.: 07217/012001
For: ELECTRONIC DEVICE

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: DECISION ON PETITION
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: UNDER 37 CFR 1.47(a)
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This is in response to applicants' "VERIFIED STATEMENT OF FACTS UNDER 37 CFR §47 BY JOHN KONSTANDELOS, MARK WHITEHEAD AND JULIE A. KENNY" which is being treated as a petition under 37 CFR 1.47(a) to accept the application without the signature of joint inventor Paul Martin Kenny filed 21 June 1999. The petition fee of 130.00 will be charged to Deposit Account no. 06-1050, as authorized in the transmittal letter.

On 04 December 1998, applicants filed a Transmittal Letter (Form PTO-1390) for entry into the national stage accompanied by, *inter alia*, the requisite basic national fee and a copy of the international application.

On 21 April 1999 the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497 must be filed. The notification set a one-month time limit in which to respond.

In order to satisfy the requirements of 35 U.S.C. 371(c)(4), applicants filed on 21 June 1999 the following papers: a transmittal letter; a petition under 37 CFR 1.47(a) and required fee; and a declaration and power of attorney signed by joint inventors John Konstandelos and Mark Whitehead.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and behalf of the non-signing joint inventor. Items (1) and (4) have been satisfied.

Concerning item (2), Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP) states, in part, "before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application paper (specification, including claims, drawings, and oath and declaration) to the nonsigning inventor for signature." A review of the present petition and the accompanying papers reveal that applicant has not satisfied the item (2) above, in that the applicant has not shown that a bona fide attempt was made to present the application papers, including the specification, claims, and drawings to Mr. Kenny. Additionally, petitioner has not provided sufficient proof that the inventor refuses to execute the application. Mr. Konstandelos, Mr. Whitehead, and Ms. Kenny have provided a declaration outlining the efforts to reach Mr. Kenny and copies of the letters sent to Mr. Kenny's attorney. However, the statements made with regards to the efforts to reach Mr. Kenny constitutes secondhand knowledge, at best, in that the majority of the actions to which applicants are averring to were conducted by McCormick Solicitors and Mitchell Solicitors. Also, refusal to sign other Patent applications does not constitute a refusal to this particular application.

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit of declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted. Where there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. Applicant has not submitted an affidavit or declaration of a person having firsthand knowledge of the facts. In the present instance, affidavits or declarations from those persons attempting to correspond with Mr. Kenny, should be presented.

In order to meet the requirements of 37 CFR 1.47(a) and Section 409.03(d) of the MPEP, a statement of facts is needed from a person having first hand knowledge of the facts that a complete copy of the application papers was sent to Mr. Kenny and when such papers were sent. In addition, copies of documentary evidence such as a certified mail return receipt, cover letter of instruction, telegrams, etc., should be supplied with the declaration.

With regard to item (3), applicant has not provided the last known address of the missing inventor.

For the reasons stated above, it would not be appropriate to accept the application without the signature of Mr. Kenny under 37 CFR 1.47(a) at this time

CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED**.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTH from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required. Extension of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention to the PCT Legal Office.



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